

DISCUSSION OF THE AMENDMENT

Claims 1-11, 17 and 24-25 are active in the present application. Claims 6-11 and 17 are presently withdrawn from consideration as non-elected subject matter. Claims 12-16 and 18-23 are canceled claims.

No new matter is added.

REQUEST FOR RECONSIDERATION

Claims 24 and 25 of the amendment filed in the present application on April 25, 2008, recite the limitations “the particles consist of silica” and “the powder consists of silica”, respectfully. The Request for Reconsideration filed in the present application on October 27, 2008 included arguments and an explanation why Claims 24 and 25 are patentable over the cited art (see the paragraph bridging pages 3 and 4 of the October 27th Request for Reconsideration).

Neither the Advisory Action nor the Office’s facsimile letter of December 3, 2008 addresses the patentability of Claims 24 and 25 in view of Applicants’ arguments.

In fact, to the contrary, the Office’s December 3rd facsimile letter makes it clear that the Office mischaracterizes the particles disclosed in the Mangold reference. For example, the Office asserts that “the product taught by the Mangold reference is substantially all silica powder...” (see the last sentence of the facsimile letter of December 3, 2008).

Applicants submit that the Office’s assertion in this regard is not correct. It is incontrovertible that the silica particles of the Mangold reference include material other than silica; namely, aluminum oxide. This characteristic of the Mangold silica is expressly set forth in the Abstract and throughout the Mangold disclosure:

Pyrogenically produced silicon dioxide doped with aluminum oxide by means of an aerosol is produced by introducing an aqueous aerosol of aluminum salt into the flame of a pyrogenic silica producing flame hydrolysis method or a flame oxidation method. Silicon dioxide doped with Al₂O₃ by means of an aerosol may inter alia be used in the product of inkjet paper or inkjet films.

See the Abstract of Mangold (U.S. 2003/0185739).

Applicants submit that it is readily evident that the U.S. publication to Mangold corresponds to the Japanese Publication cited by the Office in the Office Action of July 25, 2008.

Applicants submit that it is readily evident to those of ordinary skill in the art that a material such as silica that is “doped with aluminum oxide” does not consist of silica. The transitional phrase “consists of” has a special legal meaning. This transitional phrase signals a closed claim which excludes components not recited in the claimed invention. Here, the transitional phrase “consists of” appearing in Claims 24 and 25 excludes the compositions of Mangold because the Mangold compositions include a component, i.e., aluminum oxide, that is excluded from the presently claimed invention. Applicants thus submit that the rejection of Claim 24 and/or 25 over Mangold is not supportable and the rejection should be withdrawn.

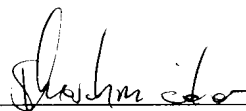
Respectfully submitted,

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